



Understanding Examination and Refusal Procedures in the IP Office of India

Madrid System Webinar

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Our experts



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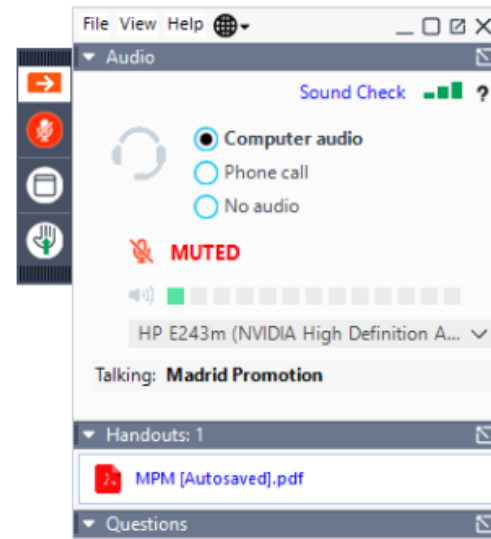


Shakti
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Deputy Registrar of
Trademarks and Geographical
Indications, IP Office of India



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Structure of the Webinar

- Presentation: Interactive questions during the webinar
- Question and answer session at the end
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- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

Understanding Examination and Refusal Procedures in India

- Overview
- Filing and Examination process in India
- Substantive examination
- Grounds for refusal
- How to avoid provisional refusals

Question 1

- When did India accede to the Madrid Protocol ?
 - 2009
 - 2011
 - 2013

India's accession to the Madrid Protocol

Feb. 8, 2007

Union Cabinet gives its approval to the India's accession to the Madrid Protocol

Jan. 14, 2013

Trademarks (Amendment) Rules, 2013 are notified

July 8, 2013

The Trademarks (Amendment) Act, 2010 and Trademarks (Amendment) Rules, 2013 are brought into effect, implementing the Madrid Protocol in India.

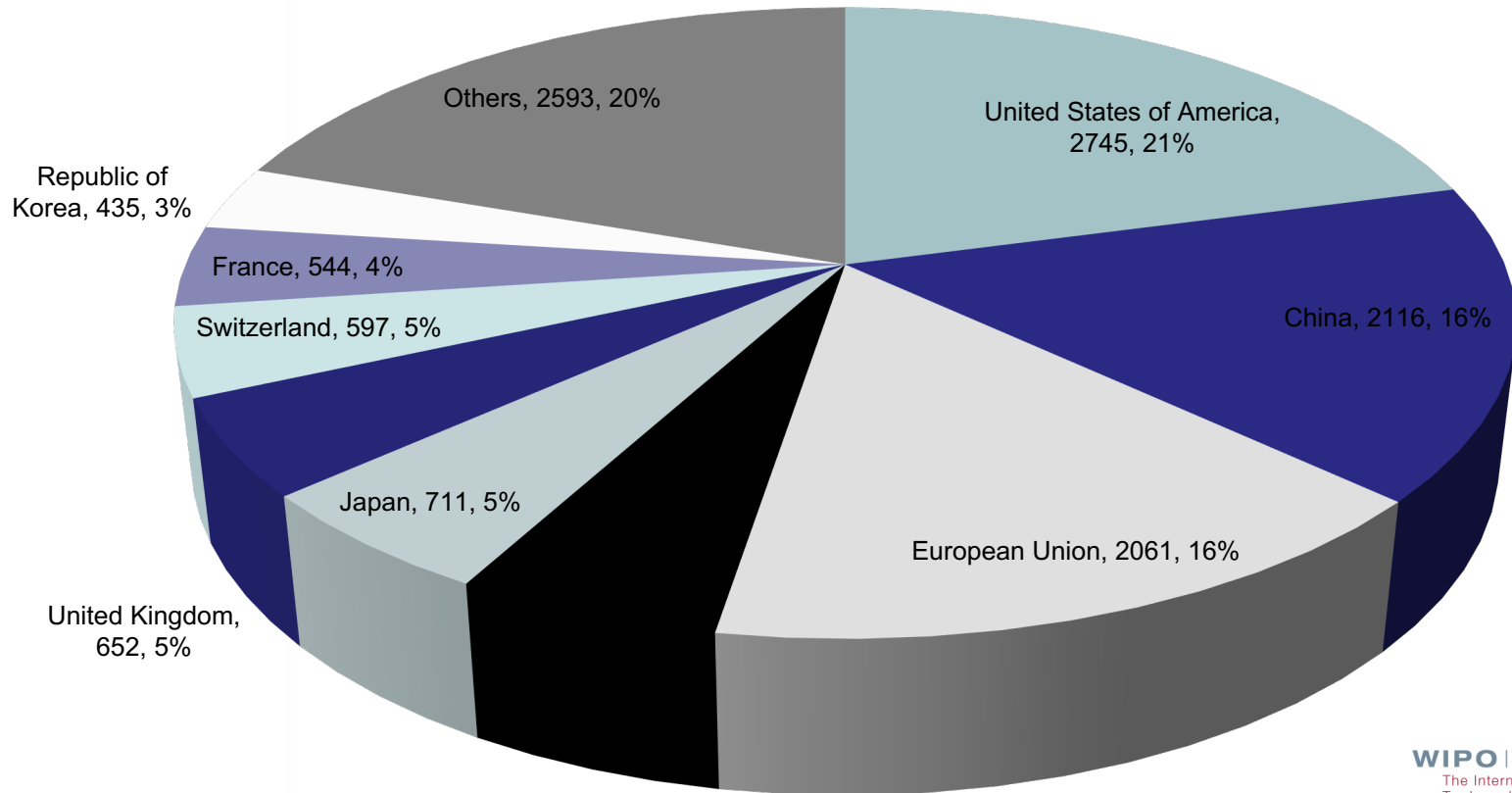
Sept. 21, 2010

The Trademarks (Amendment) Act, 2010 passes and brings the Madrid Protocol into force in India.

Apr. 8, 2013

India deposits its instrument of accession to the Madrid Protocol with WIPO

IPO's Top filers in 2020



Applications received since inception: Period 08/07/2013 to 31/03/2020

Total IRDI cases Received	76042
Statement of grant of protection sent to WIPO	55999
Confirmation of Provisional Refusal sent to WIPO	10736
IR cancelled (notification received from WIPO)	2445
Objected (Provisional refusal sent and application is under process)	4919
Opposed (Third party opposition filed, and application is under process)	1645
Rectification filed against the grant of protection	80
Published in TM Journal and under statutory waiting period	218

Question 2

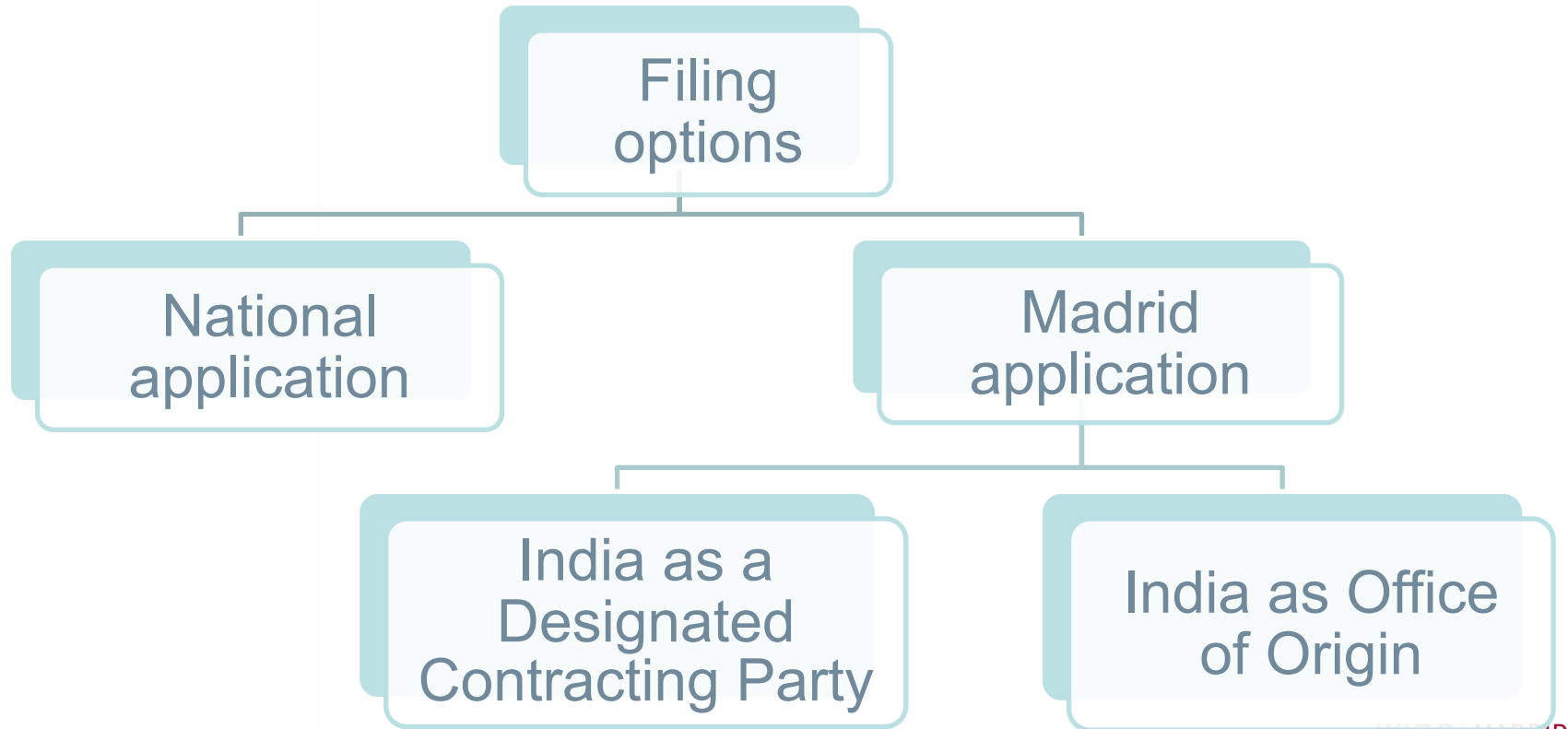
What is the percentage of provisional refusal issued by the IPO for Madrid filings?

- Around 30 – 40 %
- Around 40 – 50 %
- Around 50 – 60 %

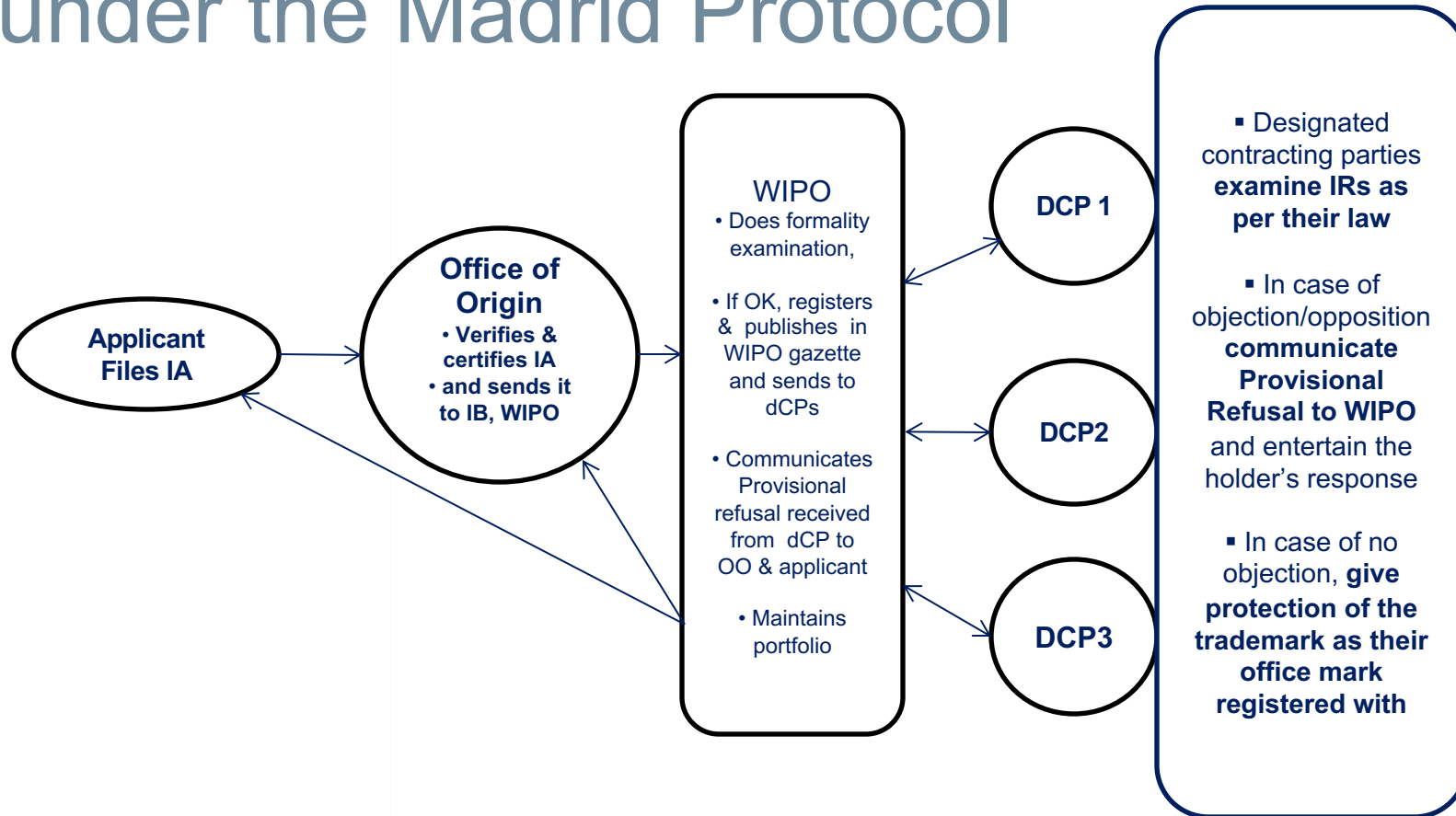
Percentage of Refusal by the IPO

Year	IRDI received	Provisional Refusal based Examination	Provisional Refusal Based opposition	Percentage of Provisional refusal
2015-16	12 221	8 353	14	68.46%
2019-20	14 004	4 484	939	38.72%

Filing of Application through Madrid System



Procedure for international registration under the Madrid Protocol



India, as an Office of Origin

- Receipt of online application through comprehensive e-filing services
- Receipt of online payment of handling fee
- Verification of application
- Deficiency letter to applicant online and receipt of their response likewise
- Certification and transmission of the application to the IB
- Online receipt of irregularity from the IB
- Transmittal of irregularity to the applicant, receipt of his input and response to the IB

Application Filing Fee under the Madrid System

- Basic fee: B/W mark (653 CHF) or Color mark (903 CHF); and
- Standard fees: Complementary fees (100 CHF) per Country and Supplementary fee *per class beyond 3* (100 CHF); or
- Individual fees
 - **India has chosen individual fees (if India is designated, the applicant must pay CHF 148 per class)**

Fees to be paid directly to WIPO

For information about fee payment to WIPO please visit:

<https://www.wipo.int/finance/en/madrid.html>

Fees can be paid by:

1. Credit card

2. Current Account at WIPO

- Debits from a [WIPO Current Account](#) are authorized either by:
- Entering your [WIPO Current Account](#) number in the online [renewal](#), [subsequent designation](#) or [payment](#) services, or
- Quoting your [WIPO Current Account](#) number in the [MM forms](#).

3. Bank and postal transfer

Filing Process: India as a Designated Country

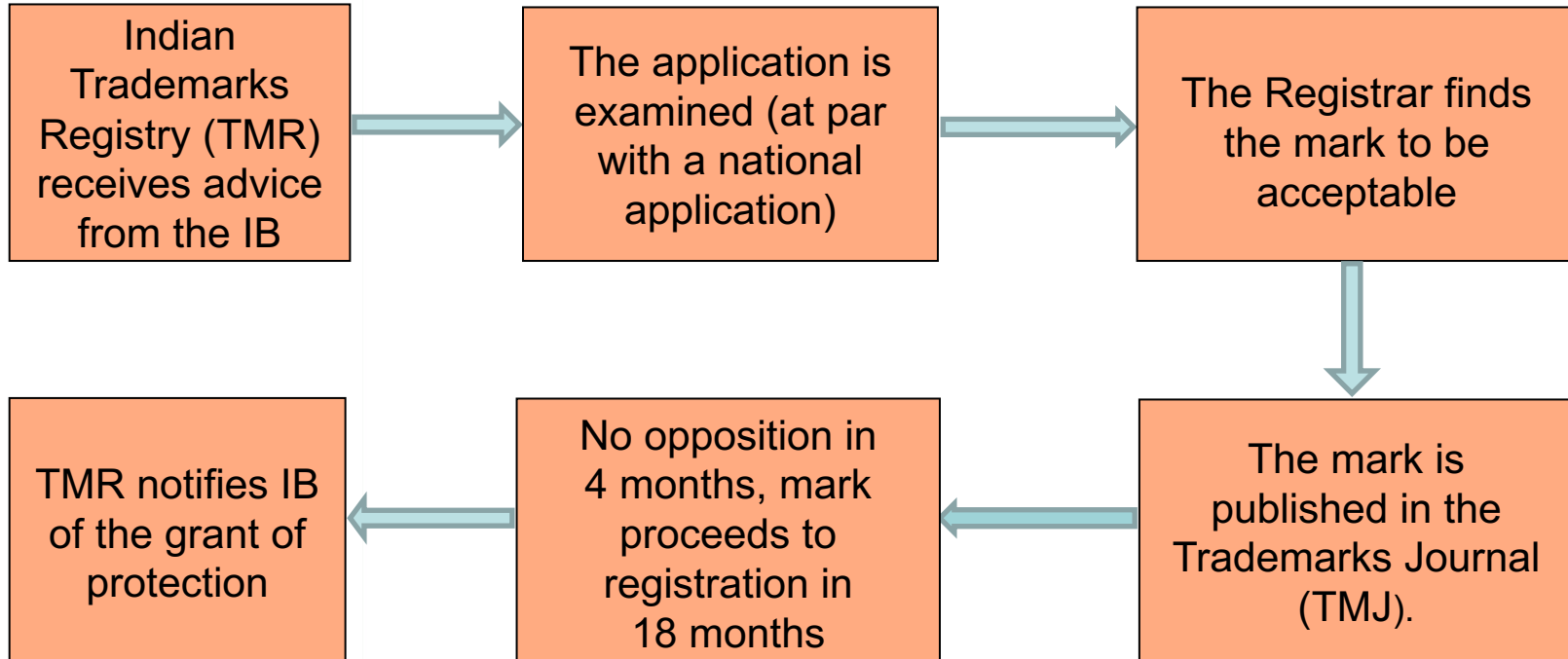
- Where International Registration (IR) protection is extended to India based on a basic application/ registration filed in another country.

Who can file application for international registration ?

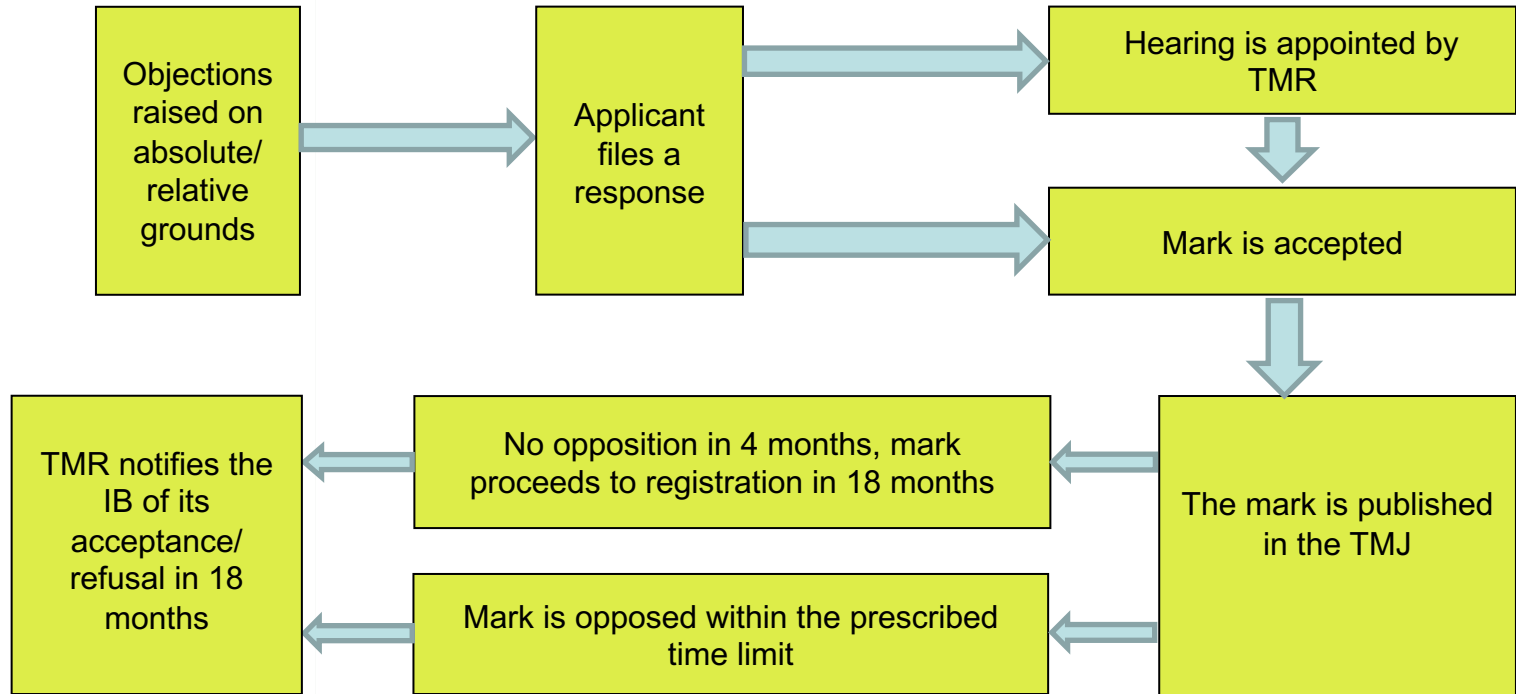
Any person (including a legal entity)

- who has a connection with a country which is member of the same treaty under Madrid System, and
- who has a trademark registered or pending for registration in that country can make application for international registration of trademarks. The application for international registration is to be made by the same person for the same trademark and in respect of goods or services covered in the domestic application or registration.

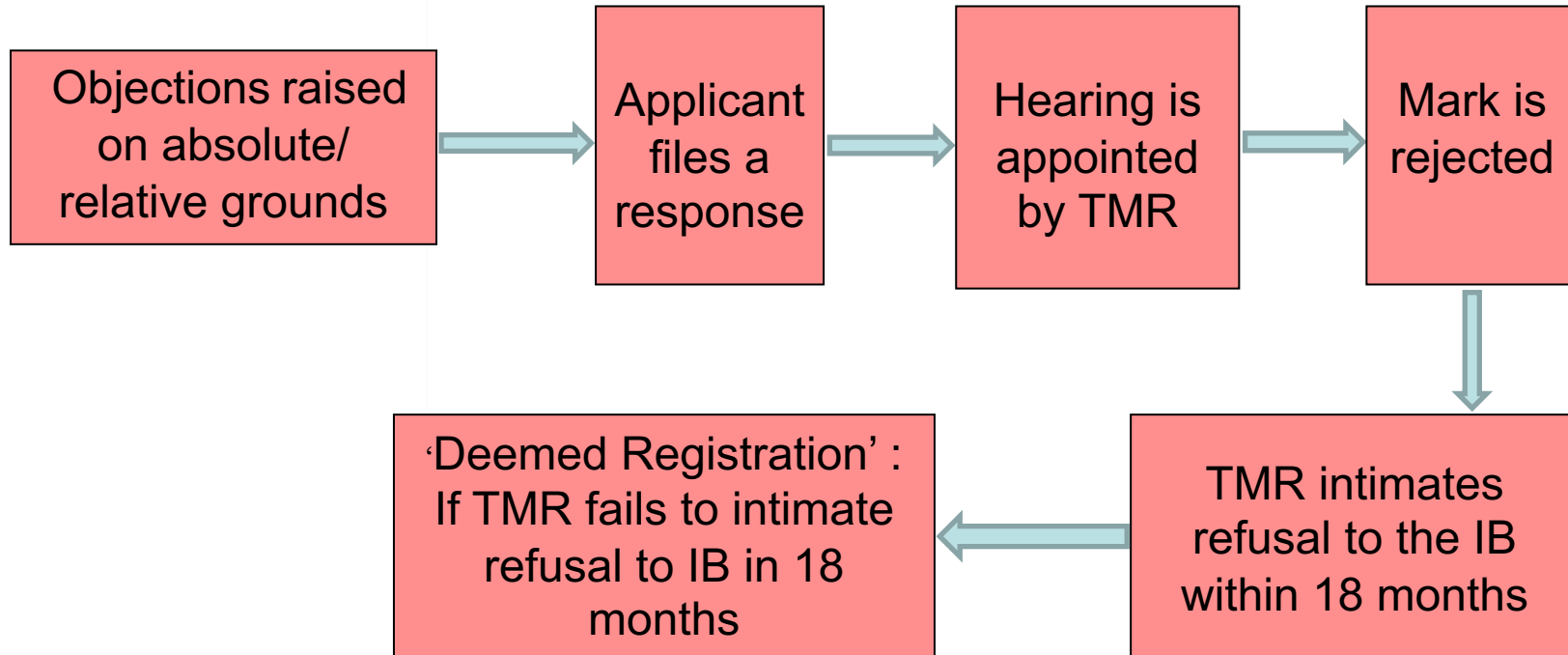
Possibility A: the mark is directly accepted by the registry



Possibility B: objections are raised by the registry (Objections Overcome)



Possibility C: objections are raised by the registry (Objections Maintained)



Understanding the “18-month period”

- The 18-month period begins from the date of notification of the designation to the Indian Registry by the IB.
- The Indian Registry must send a provisional refusal or a statement of grant of protection to the IB within the 18-month time-limit.
- In case of a provisional refusal notified within the 18-month period, the final refusal/acceptance may be conveyed later.

Understanding the “18-month period”

- The 18-month period begins from the date on which the Indian Registry receives an advice for an International Application from the IB.
- The obligation for the Indian Registry to comply with the 18-month time limit is limited ONLY to reverting to the IB with its initial take on the International Application.
- In case of a provisional refusal intimated within the 18-month period, the final refusal/acceptance may be conveyed later.

Filing Process: India as Office of Origin

- Where an application for international registration is filed through the Indian Registry to obtain protection in different countries / Contracting Parties based on a basic application / registration filed in India.

Who can file application for international registration ?

Any person (including a legal entity)

- who has an **entitlement** (connection) with a Contracting Party of the Madrid System; and
- who has a trademark registered or pending for registration (**basic mark**) in the IP Office of that Contracting Party (Office of origin)
- can submit an **international application** through this same IP Office, which will certify and forward it to WIPO
- The international application is to be made by the same person for the same trademark and in respect of goods or services covered in the basic mark.

Who can file application for international registration ?

- “*real and effective industrial or commercial establishment*” should be interpreted as per the local laws of the designated Contracting Party.
- “Real and effective industrial or commercial establishment” means a place where any bona fide industrial or commercial activity takes place. It need not be a principal place of business.
(*Explanation to Section 36B(a) of the Act*)

Question 3

In which city are located the Headquarters of the Indian IP office ?

- Delhi
- Mumbai
- Chennai

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MM 2

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Contracting party whose office is the office of origin : India

1 Language : English French Spanish

2 APPLICANT'S DETAIL

Applicant's Name :

Address : Telephone No :

Mailing Address : Post Code :

Email : Fax No. :

Country : Nationality :

Legal Nature : Place Incorporation :

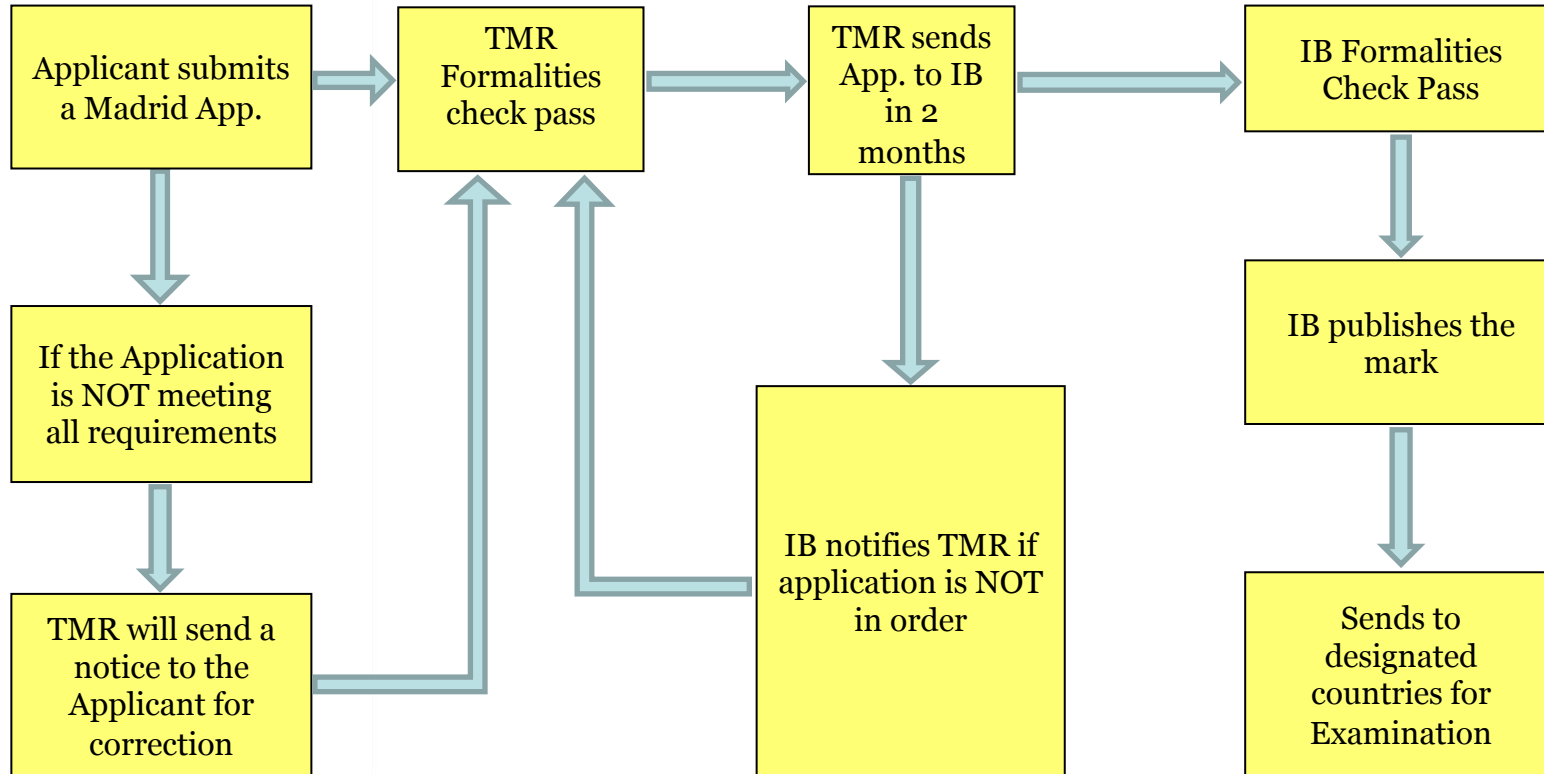
Preferred Language : English French Spanish

3 ENTITLEMENT TO FILE

- Where the Contracting Party is a State, the applicant is a national of that State; or
- where the Contracting Party is an organization, the name of the State of which the applicant is a national; ;
- or
- the applicant is domiciled in the territory of the Contracting Party or
- the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party

[Add Applicant](#)

Flow of Madrid Procedure in India



Pendency in Examination in term of time:

2015-16	12-13 months time for examination of the TM after received from WIPO.
2020-21	at present application get examined within 2 weeks after receipt from WIPO

Changes in the Indian Act

- New chapters have been added to the Act (chapter IVA) and the Rules (chapter IIIA), enlisting provisions vis-à-vis the Madrid Protocol.
- India's chosen official language for all documents to and from the IB is English.
- All documents to and from the IB will be in electronic form.
- The Indian Registry will have to take a call (accept/object) on all International Applications within 18-month time period, failing which, the mark shall be deemed to be registered.

Question 4

What types of trademarks are not protected in India?
(only 1 answer)

- Sound marks
- Three-dimensional marks
- Smell marks
- Color combination marks
- Collective / Certification

Types of trademarks protected in India

- Three dimensional marks
- Sound marks
- Color combination marks
- Collective / Certification

Trademarks – Not Fit For Registration

(Absolute Ground of Refusal)

I. Such marks are devoided of any distinctive character. [sec. 9 (1) (a)].

Examples of such marks are:

- Name of individual, Common surnames, Significant geographical names of places, Name of sect, caste or tribe in India, Names of rivers, mountains, seas and lakes that reflect an association with the goods, Numerals per se

Distinctiveness – meaning

- that public can recognize it as a trademark;
- that it enables the public to identify the source of origin.

Trademarks – Not Fit For Registration

Contd...

II. DESCRIPTIVE MARKS being such marks that consist exclusively of marks or indications, which may serve in trade to designate the kind, quality, intended purpose, values, geographical origin or other characteristic of the goods or services i.e. those which are descriptive in nature or even laudatory. [Sec. 9 (1)(b)]

For example:

- KIND – “Extra large”, “Large”, “Small”.
- QUALITY – “Good”, “Best”, “Superb”, “Fine”, “Perfect”, “Supreme”, “Hightech”, “ Superior”, “ULTRA”, “Orlwoola”
- QUANTITY – KILO, LITRE, GRAM, Numeral 12 would not be acceptable for wine (12 bottles = one case of wine).
- Similarly 52 for playing cards. Similarly 1000 (1000=1Kg) for say butter.

Trademarks – Not Fit For Registration

Contd...

- INTENDED PURPOSE – “SAFFO” for cleaning powder; “TWIST AND CURL” for hand implements operated by a twisting action for curling the hair; “SLIM AND FIT” for slimming preparations . Words which describe the effect of the goods / services would also be open to objection as a characteristic of the goods /services, for example “RUSTFREE” for paints or in case of articles made of steel.
- Words or symbols which merely serve to indicate the worth, merit or importance of the goods or services. Examples are “ BUDGET” for car rental services, “ECONOMY”, "TWO FOR ONE”; “MONEYWORTH”; “WORTH THEIR WEIGHT IN GOLD”.

Trademarks – Not Fit For Registration

Contd...

- GEOGRAPHICAL NAMES – “ALIGARHIA” for locks, “FIROZABADI BANGLES”, “RAJASTHANI MARBLE”, “SURAT SAREES”. “ITALIAN” or “CHINESE” for restaurant, “PARIS” for fashion design.

- The principle is:
 - The name of a place applied in relation to goods/services will prima facie be taken to indicate their origin, and hence non-distinctive .
 - where there are more than one person manufacturing the same goods in a place, the name of that place will be incapable of acquiring a distinctive character as a trademark”

Trademarks – Not Fit For Registration

Contd...

Applicable principles to decide descriptiveness:

- The mark has to be considered in relation to the goods and it is to be considered as to what it would mean to the average purchaser concerned with such goods.
- The speed of the mental reaction of the purchaser to the word has to be considered.
- One must also consider particular customers concerned in the goods, whether these are bought by the general public or by a select and restricted class of very knowledgeable purchasers.

Trademarks – Not Fit For Registration

Contd...

III. Such marks consist exclusively of marks or indications which have become customary in the current language or in the bonafide and established practices of trade [Sec. 9(1) (c)]

Examples:

- ESCALATOR
- MOZZARELLA
- YELLOW PAGES

Trademarks – Not Fit For Registration

Contd...

- IV. Marks of such nature as to deceive the public or cause confusion. [Sec. 2(a)] e.g. “HONEY’S JAMMY” for mix fruit jam.
- V. Marks containing or comprising of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India. [Sec. 2(b)] e.g. “KRISHNA” for meat, “786” for sanitary apparatus.
- VI. Marks comprising or contain scandalous or obscene matter. [Sec. 2(c)] e.g. “BASTARD”, “FUQ”, “SEX ROD”, “PHALLUS”, “VAGINAS”

Question 5

■ Who prepares the list of Non-Proprietary names (INN)?

■ WIPO

■ WTO

■ WHO

Trademarks – Not Fit For Registration

- VII. Marks prohibited under the Emblems & Names (Prevention of Improper Use Act). [Sec. 2(d)]. e.g. “BALAJI”, “SAI BABA”, “SHIVAJI”.
- VIII. Marks exclusively consisting of shape –
- which results from the shape of goods for e.g. banana shape for bananas.
 - the shape of goods which is necessary to obtain a technical result.
 - which gives substantial value to the goods. e.g. diamond shape for diamonds.
- IX. Commonly used and acceptable name of single chemical element or compound marks in respect of chemical or Declared by WHO and notified by Registrar of TM as Non-Proprietary names (INN). [Sec. 13]

Trademarks – Not Fit For Registration

(Relative Ground of refusal)

- I. Marks, which are identical or similar to earlier marks [Sec. 11 (1)]
i.e. say:
 - a. Identical with earlier mark and having similarity of goods with the earlier mark [Sec. 11(1) (a)]; or
 - b. Similarity with the earlier mark and having identity or similarity of the goods or services covered by the earlier trademark [Sec. 11(1) (b)].
- II. Marks, which are identical or similar to well-known marks though the goods or services may be entirely different [Sec. 11 (2)(a),(b).
- III. Marks prohibited by any law in particular the law of passing off [Sec 11(3)(a)] or by virtue of law of copyright[Sec. 11(3)(b)]

Trademarks – Not Fit For Registration

Contd...

- The identity or similarity is such that :
 - there is likelihood of confusion on the part of public;
 - There is likelihood of association with the earlier trademark amongst the public.

- The fundamental principles are:
 - The mark has to be considered as a whole; and
 - The test is that of a man of ordinary man with imperfect re-collection.

IPO – International Trademark Registration

- Trademarks Registry Mumbai
 - Madrid System applications
 - Support system to stakeholder in issues related to Madrid System

- Helpline phone number: +91 22 24134555
- Dedicated email: madrid.tmr@nic.in

Guidelines

- A document titled as ‘Guidelines for functioning under the Madrid Protocol’ is put up on the home page of official website of the CGPDTM – www.ipindia.nic.in
- A booklet named ‘Madrid Protocol – a Route to Global Branding’ is prepared and put up on the official website



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